



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,246	06/27/2000	Toru Ebihara	500.38711X00	5041

20457 7590 06/18/2004

ANTONELLI, TERRY, STOUT & KRAUS, LLP  
1300 NORTH SEVENTEENTH STREET  
SUITE 1800  
ARLINGTON, VA 22209-9889

EXAMINER

HAQ, NAEEM U

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 06/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/604,246

Applicant(s)

EBIHARA ET AL.

Examiner

Naeem Haq

Art Unit

3625

NHW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10, 11, 14, 15, 18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10, 11, 14, 15, 18 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>14</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

This action is in response to the Applicants' RCE and amendment C, paper numbers 13 and 14, filed on March 23, 2004. Claims 1-9, 12, 13, 16, and 17 have been canceled. New claims 18 and 19 have been entered. Claims 10, 11, 14, 15, 18 and 19 are now pending and will be considered for examination.

### ***Claim Objections***

Claim 10 is objected to because of the following informalities: This claim recites the limitation "the way" in line 16 of the claim. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 10, 11, 14, 15, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada (US 6,336,100 B1) in view of Walker et al. (US 6,108,639) and Kargman et al. (US 2002/0038261 A1) and further in view of Official Notice.**

Referring to claims 10, 14, and 18, Yamada teaches a system and method of ordering and delivering merchandise using a computer system opening virtual stores on

Art Unit: 3625

a network, said computer system comprising: a server; a memory unit storing merchandise information, selection information about user's merchandise reception, dealer information and including an order data file for storing orders from customers (column 2, lines 10-56), said system and method comprising the steps: in said server, accepting access to said virtual store from a user terminal connected to the server through the network (column 2, lines 12-17, lines 25-33; Figure 1, items "1" and "3"); providing merchandise information stored in said memory unit to said user terminal through the network (column 4, lines 41-48; Figure 8); accepting an order of merchandise from the user on the basis of said merchandise information (column 4, lines 49-67; column 5, lines 1-12); reading selection information concerning a way of receiving said ordered merchandise from said memory unit to provide the read selection information to said user terminal through a network (column 3, lines 6-30); accepting a way of receiving merchandise selected based on said read selection information from said user terminal (column 3, lines 6-30); accepting a specific dealer selected among the dealers from user terminal (column 3, lines 6-30); providing the user terminal with confirmation information including the way of receiving merchandise to the user terminal through the network based on said order information (column 3, lines 55-65). Yamada also teaches determining that the selected receiving way indicates dealers capable of dealing or mediating merchandise as a delivery destination (column 3, lines 6-12; column 4, lines 27-40), and determining that said receiving way indicates a dealer (column 4, lines 27-40). Yamada does not teach that the merchandise information, the selected receiving way, or the accepted specified dealer are written to an order file.

Art Unit: 3625

However, Walker teaches a system and method of ordering online wherein the merchandise information, the selected way of receiving, and the accepted specified dealer are written to an order file (Figure 7, items "744", and "750"). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Walker into the invention of the Yamada. One of ordinary skill in the art would have been motivated to do so in order to create a record of the transaction in the event a dispute or disagreement occurred at a later time. Yamada does not teach determining that a contract of sales regarding said ordered merchandise is made. However, Walker teaches this limitation (column 3, lines 23-38; column 5, lines 58-62). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings Walker into the system and method of Yamada. One of ordinary skill in the art would have been motivated to do so in order to guarantee payment to the seller. The cited prior art does not teach preparing a delivery schedule on the basis of a condition of the contract by referring to information on past delivery schedules. However, Walker teaches that a conditional purchase offer (CPO) is a legally binding contract that allows the buyer to state the terms and conditions of the contract (column 5, lines 7-20; column 5, lines 58-67). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have the buyer state the delivery terms and conditions in the CPO. One of ordinary skill in the art would have been motivated to do so in order to allow the buyer to express his or her need to take possession of the product at a time most convenient to the buyer. Yamada does not teach reading out order information

Art Unit: 3625

written in said order data file and sending a notice of a predetermined format including information of a merchandise delivery schedule based on which arrival of the ordered merchandise is informed to a sales merchant, to a terminal of said dealer. However, Walker teaches that a CPO is provided to potential seller (column 9, lines 62-67) and to the dealers (column 6, lines 41-46). Yamada does not teach monitoring whether inspection information indicating that said ordered merchandise has arrived at said dealer is received from said dealer terminal through a communication line. However, Walker teaches this limitation (column 4, lines 12-20; column 5, lines 21-39; column 7, line 63 – column 8, line 11; column 11, lines 40-46). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Walker into the system and method of Yamada. One of ordinary skill in the art would have been motivated to do so in order to guarantee that the item had been properly validated and authenticated by a third party. Yamada and Walker do not teach that the monitoring occurs within a predetermined period based on the delivery schedule. However, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this into the cited prior art because Walker's CPO allows a buyer to set the terms of the contract. One of ordinary skill in the art would have been motivated to do so in order to allow the buyer to stipulate his or her time constraints in the CPO. Yamada also does not teach retrieving map information by a map information display unit based on dealer information stored in said memory unit to provide the retrieved map information to said user terminal, said map information including a dealer of a neighborhood of the delivery destination in the

Art Unit: 3625

region of said map on the basis of a user's address or an address input by said user. However, Kargman teaches a system and method for placing an order through the Internet wherein a store street-map is retrieved to identify a dealer within or near a user-specified street and/or zip code address (page 1, paragraph [0003]; page 2, paragraph [0014]). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Kargman into the system and method of Yamada and Walker. One of ordinary skill in the art would have been motivated to do so in order to identify a dealer closest to the customer as taught by Yamada and Kargman. The cited prior art does not explicitly teach a map information display unit for displaying a map on a user terminal. However, Official Notice is taken that displaying a map on a user terminal is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to provide a user with a graphically enriched display so that information about the dealer could be more easily conveyed to the user.

Referring to claims 11, 15, and 19, Yamada does not teach determining that said merchandise inspection information exists and, monitoring whether delivery information indicating that the merchandise has been handed over to the user at said dealer is received from said dealer in said predetermined period through the communication line. However, Walker teaches this limitation (column 5, lines 21-39). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made,

Art Unit: 3625

to incorporate these features into the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to authorize payment to the seller, as taught by Walker.

### ***Response to Arguments***

Applicant's arguments with respect to claims 10, 11, 14, and 15 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application, applicant should promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR 1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a substantial delay by the Office in fulfilling the order for the copy of the provisional application. Where the applicant has been notified on the PTO-892 that a copy of the provisional application is not readily available, the provision of MPEP



Art Unit: 3625

§ 707.05(a) that a copy of the cited reference will be automatically furnished without charge does not apply.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

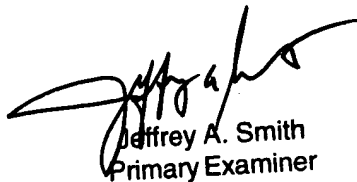
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (703)-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Naeem Haq**, Patent Examiner  
Art Unit 3625

June 8, 2004



Jeffrey A. Smith  
Primary Examiner